UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,831	02/11/2004	Barry J. Thurlow	D/A3323	3021

7590   06/20/2008

Patent Documentation Center
Xerox Corporation,
Xerox Square 20th Floor
100 Clinton Ave. S.
Rochester, NY 14644

EXAMINER
DULANEY, BENJAMIN O

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
06/20/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/776,831	THURLOW, BARRY J.
	Examiner	Art Unit	
	BENJAMIN O. DULANEY	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>11 February 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-23</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-23</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 11, examiner does not see where the specification enables one skilled in the art to determine a location of a printer using capability data of that printer. For example, one skilled in the art would not generally know how to determine the location of a printer using only information such as whether it can print in color, nor is this process explained in the specification. Therefore, appropriate correction is required.

Regarding claim 12, examiner does not see where the specification enables one skilled in the art to determine a location of a printer using a requirement of the print job being sent to that printer. For example, one skilled in the art would not generally know how to determine the location of a printer using only information such as a job is selected to print duplex, nor is this process explained in the specification. Therefore, appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

1)   Claims 1-6, 8, 11, 12 and 18-21 are rejected under 35 U.S.C. 102(e) as being

anticipated by U.S. patent 6,552,813 by Yacoub.

2)   Regarding claim 1, Yacoub teaches a method of operating a plurality of printers,

comprising: retaining geographical data for each of the plurality of printers (Column 5,

lines 64-66); and retaining relational data relating to the geographical data of the

plurality of printers, the relational data being useful in determining an effective distance

between a printer and a predetermined location (Column 5, line 66 – Column 6, line 15).

3)   Regarding claim 2, Yacoub teaches the method of claim 1, the relational data

being retained in a server, the server being accessible to a computer originating a job to

be printed (column 5, line 64; figure 4, item 460).

4)   Regarding claim 3, Yacoub teaches the method of claim 1, further comprising

determining that a first printer of the plurality of printers is unsuitable for a purpose

(column 6, lines 34-42); and using the relational data to find a second printer of a predetermined geographical relationship to the first printer (column 6, lines 4-15).

5)   Regarding claim 4, Yacoub teaches the method of claim 1, further comprising determining an effective distance of at least one printer to a predetermined location, using the geographical data and the relational data (column 6, lines 4-10).

6)   Regarding claim 5, Yacoub teaches the method of claim 1, further comprising determining an effective distance of at least two printers to a predetermined location, using the geographical data and the relational data (column 6, lines 4-10); and displaying information about at least one printer of the at least two printers (column 7, lines 35-37).

7)   Regarding claim 6, Yacoub teaches the method of claim 5, further comprising displaying an indication that one printer of the at least two printers has a smaller effective distance to the predetermined location than another of the at least two printers (column 7, lines 35-37; since the choice of the printer involves the distance from the user, the printer chosen for the user that is displayed is an "indication" of a shorter distance).

8)   Regarding claim 8, Yacoub teaches the method of claim 1, the relational data relating to a grid system (column 5, lines 64-66; Cartesian coordinates is a grid system).

9)   Regarding claim 11, Yacoub teaches the method of claim 1, the relational data taking into account capability data of a printer to determine whether the printer is near a predetermined location (column 3, lines 62-64).

10)   Regarding claim 12, Yacoub teaches the method of claim 1, the relational data taking into account a requirement of a desired print job to determine whether the printer is near a predetermined location (column 6, line 50 – column 7, line 9).

11)   Regarding claim 18, Yacoub teaches the method of claim 1, the geographical data for each printer including grid coordinates (column 5, lines 64-66; Cartesian coordinates is a grid system).

12)   Regarding claim 19, Yacoub teaches the method of claim 1, further comprising retaining capability data for each of the plurality of printers (column 3, lines 62-64).

13)   Regarding claim 20, Yacoub teaches the method of claim 19, further comprising determining whether a printer in the plurality of printers is suitable for a purpose, referring to the capability data of a printer in the plurality of printers (column 6, line 60 – column 7, line 9).

14)   Regarding claim 21, Yacoub teaches the method of claim 19, the capability data for each printer including data about whether the printer can print in color (column 4, lines 10-13).

Claim Rejections - 35 USC § 103

    The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

    (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15)   Claims 7, 9, 10, 15-17 and 22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. patent 6,552,813 by Yacoub as applied to claim 1 above, and

further in view of U.S. patent 6,665,712 by Pickup.

16)   Regarding claim 7, Yacoub does not specifically teach the method of claim 4,

further comprising displaying a map showing a location of the at least one printer.

       Pickup teaches the method of claim 4, further comprising displaying a map

showing a location of the at least one printer (figure 2; column 3, lines 45-50).

       Yacoub and Pickup are combinable because they are both from the printing field

of endeavor.

       It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to combine Yacoub and Pickup to add displaying a map. The

motivation for doing so would have been to "allow the user to more quickly reach the

printer" (column 3, line 49). Therefore it would have been obvious to combine Yacoub

with Pickup to obtain the invention as specified by claim 7.

17)   Regarding claim 9, Yacoub does not specifically teach the method of claim 1, the

relational data taking into account distances between buildings in which printers of the

plurality of printers reside.

       Pickup teaches the method of claim 1, the relational data taking into account

distances between buildings in which printers of the plurality of printers reside (column

4, lines 30-33; if all printers GPS coordinates are known then the distance between

printers would inherently include the distances between the buildings that held them).

Yacoub and Pickup are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Yacoub and Pickup to add GPS locations. The motivation for doing so would have been to pinpoint a location. Therefore it would have been obvious to combine Yacoub with Pickup to obtain the invention as specified by claim 9.

18)   Regarding claim 10, Yacoub does not specifically teach the method of claim 1, the relational data taking into account different floors within a building in which printers of the plurality of printers reside.

Pickup teaches the method of claim 1, the relational data taking into account different floors within a building in which printers of the plurality of printers reside (column 6, lines 4-38).

Yacoub and Pickup are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Yacoub and Pickup to take into account floors in a building. The motivation for doing so would have been to direct a user to an output device (column 6, line 22). Therefore it would have been obvious to combine Yacoub with Pickup to obtain the invention as specified by claim 10.

19)   Regarding claim 15, Yacoub does not specifically teach the method of claim 1,

the geographical data for each printer including data about a building in which the

printer is located.

Pickup teaches the method of claim 1, the geographical data for each printer

including data about a building in which the printer is located (figure 3; column 4, lines

37-39).

Yacoub and Pickup are combinable because they are both from the printing field

of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to combine Yacoub and Pickup to take into account a building

layout. The motivation for doing so would have been to direct a user to an output device

(column 6, line 22). Therefore it would have been obvious to combine Yacoub with

Pickup to obtain the invention as specified by claim 15.

20)   Regarding claim 16, Yacoub does not specifically teach the method of claim 1,

the geographical data for each printer including data about a location within a building in

which the printer is located.

Pickup teaches the method of claim 1, the geographical data for each printer

including data about a location within a building in which the printer is located (figure 2;

column 3, lines 45-50).

Yacoub and Pickup are combinable because they are both from the printing field

of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Yacoub and Pickup to take into account a building layout. The motivation for doing so would have been to direct a user to an output device (column 6, line 22). Therefore it would have been obvious to combine Yacoub with Pickup to obtain the invention as specified by claim 16.

21)   Regarding claim 17, Yacoub does not specifically teach the method of claim 1, the geographical data for each printer including GPS-useable information describing a location of the printer.

Pickup teaches the method of claim 1, the geographical data for each printer including GPS-useable information describing a location of the printer (column 4, lines 30-33).

Yacoub and Pickup are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Yacoub and Pickup to add GPS data. The motivation for doing so would have been to direct a user to an output device (column 6, line 22). Therefore it would have been obvious to combine Yacoub with Pickup to obtain the invention as specified by claim 17.

22)   Regarding claim 22, Yacoub does not specifically teach the method of claim 19, the capability data for each printer including data about whether the printer can perform a desired finishing operation.

Pickup teaches the method of claim 19, the capability data for each printer
including data about whether the printer can perform a desired finishing operation
(column 1, lines 23-24).

Yacoub and Pickup are combinable because they are both from the printing field
of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the
invention was made to combine Yacoub and Pickup to add stapling capability data. The
motivation for doing so would have been to select the best output device (column 1, line
27). Therefore it would have been obvious to combine Yacoub with Pickup to obtain the
invention as specified by claim 22.

23)   Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.
patent 6,552,813 by Yacoub as applied to claim 1 above, and further in view of U.S.
patent 5,832,191 by Thorne.

Yacoub does not specifically teach the method of claim 1, the geographical data
for each printer including data about public accessibility of the printer.

Thorne teaches the method of claim 1, the geographical data for each printer
including data about public accessibility of the printer (column 4, lines 40-52).

Yacoub and Thorne are combinable because they are both from the printing field
of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the
invention was made to combine Yacoub and Thorne to add public accessibility data.

The motivation for doing so would have been to indicate printer availability (column 4, line 49). Therefore it would have been obvious to combine Yacoub with Thorne to obtain the invention as specified by claim 13.

24)   Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,552,813 by Yacoub as applied to claim 1 above, and further in view of U.S. patent 7,136,941 by Nguyen et al.

Yacoub does not specifically teach the method of claim 1, the geographical data for each printer including data about security properties of the printer.

Nguyen teaches the method of claim 1, the geographical data for each printer including data about security properties of the printer (column 25, line 57 – column 26, line 8).

Yacoub and Nguyen are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Yacoub and Nguyen to add security data. The motivation for doing so would have been to "convey" printer security information (column 25, line 58). Therefore it would have been obvious to combine Yacoub with Nguyen to obtain the invention as specified by claim 14.

25)   Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

patent 6,552,813 by Yacoub as applied to claim 1 above, and further in view of U.S.

patent application publication 2004/054623 by Collins et al.

Yacoub does not specifically teach the method of claim 19, the capability data for

each printer including data about whether the printer can output special characters.

Collins teaches the method of claim 19, the capability data for each printer

including data about whether the printer can output special characters (paragraph 28;

barcodes are special characters according to applicant's specification).

Yacoub and Collins are combinable because they are both from the printing field

of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to combine Yacoub and Collins to add printing special characters.

The motivation for doing so would have been to print barcodes for such things as

lotteries (paragraph 28). Therefore it would have been obvious to combine Yacoub with

Collins to obtain the invention as specified by claim 23.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to BENJAMIN O. DULANEY whose telephone number is

(571)272-2874. The examiner can normally be reached on Monday - Friday (10am -

6pm).

　　　　If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

　　　　Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

　　　　/Benjamin O Dulaney/

　　　　Examiner, Art Unit 2625

　　　　/David K Moore/

　　　　Supervisory Patent Examiner, Art Unit 2625